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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,876	11/17/2005	Fumio Kurihara	275546US3PCT	1833
22850	7590	01/08/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER THROWER, LARRY W	
			ART UNIT	PAPER NUMBER
			1791	
			NOTIFICATION DATE	DELIVERY MODE
			01/08/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/542,876	Applicant(s) KURIHARA ET AL.
	Examiner LARRY THROWER	Art Unit 1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 9-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/12/2007; 7/20/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group 1, claims 1-8 in the reply filed on November 26, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 9-17 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-8** are rejected under 35 U.S.C. 102(b) as being anticipated by Chen *et al.* (US 6,068,809).

- Regarding **claim 1**, Chen *et al.* discloses a mold for injection molding (abstract).

The mold includes a mold cavity (14) having an inside shape fit to an outside shape of a target product (figs. 4-7), and a temporary space (18) being communicated with the mold cavity and capable of being eliminated (figs. 4-7). With respect to the recitation "...eliminated before an amount of a molten material being injected to the

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mold cavity reaches the capacity of the mold cavity," this language is taken to be an intended use. It is well settled that the recitation of a new intended use for an old apparatus does not make a claim to that old apparatus patentable. See *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962) (statement of intended use in an apparatus claim failed to distinguish over the prior art apparatus); *In re Hack*, 245 F.2d 246, 248, 114 USPQ 161, 162 (CCPA 1957) ("the grant of a patent on a composition or a machine cannot be predicated on a new use of that machine or composition").

- Regarding **claim 2**, Chen *et al.* discloses a mold for injection (abstract). The mold includes a mold cavity (14) having an inside shape fit to an outside shape of a target product (figs. 4-7), a junk cavity (15) being communicated with the mold cavity, and a temporary space (18) being communicated with the mold cavity and capable of being eliminated (figs. 4-7). With respect to the recitation "...eliminated before an amount of a molten material being injected to the mold cavity reaches the capacity of the mold cavity," this language is taken to be an intended use.
- Regarding **claim 3**, Chen *et al.* discloses the mold cavity (14a, 14b; fig. 3) having two gates (15a, 15b) that are capable of being controlled to start injection, the temporary space (18) being a ditch having an eliminator (132; fig. 4) capable of eliminating the ditch and being set on the surface of the mold cavity where it connects opening portion of the two gates (at the top and bottom of temporary space 18) that are mutually adjacent (fig. 4), a second gate which is one of the mutually adjacent two gates is capable of being opened after a melt-front of a molten material

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injected from a first gate being the other of the two gates reaches the second gate.

With respect to the recitation "...a molten material being progressed in the ditch is pushed and returned to the mold cavity by using the eliminator, the eliminator is started with a melt-front of a molten material from the first gate reaches the position of the second gate," this language is taken to be an intended use.

- Regarding **claim 4**, Chen *et al.* discloses the temporary space (18) being a ditch having an eliminator (132; fig. 4) capable of eliminating the ditch and being set on the surface of the mold cavity in the longitudinal direction from the opening portion of the gate of the mold cavity (fig. 4). "...a molten material being progressed in the ditch is pushed and returned to the mold cavity by using the eliminator; said eliminator is started when a melt-front of a molten material from said gate reaches the end of the ditch" is taken to be an intended use.
- Regarding **claim 5**, Chen *et al.* discloses the temporary space (18) being situated in the mold cavity space and delimited and capable of being eliminated at a predetermined time by an eliminator (132), the eliminator being a movable pin having the outside shape fit to the inside shape of the through hole of a target product (fig. 4). "...and is started to be inserted to the mold cavity to occupy the temporary space when the melt front of a molten material passed the position of the temporary space" is taken to be an intended use.
- Regarding **claims 6 and 8**, Chen *et al.* discloses the pin being capable of being driven by an oil hydrolic mechanism (fig. 3).

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- Regarding **claim 7**, Chen *et al.* discloses the mold cavity having a body corresponding to a through hole of a target product and jut into the mold cavity space to cause a branch and a confluence of the molten material (figs. 3-7), the temporary space being set at the confluence side of the body and capable of being eliminated (figs. 4-7). "...said eliminator is started to eliminate the temporary space to push and return a molten material accumulated in the temporary space to the mold cavity" is taken to be an intended use.
5. **Claims 1 and 5** are rejected under 35 U.S.C. 102(b) as being anticipated by Honda (JP 60-166416).
- Regarding **claim 1**, Honda discloses a mold for injection molding (abstract). The mold includes a mold cavity having an inside shape fit to an outside shape of a target product, and a temporary space being communicated with the mold cavity and capable of being eliminated (page 3, upper right column, line 20 to lower right column, line 5). With respect to the recitation "...eliminated before an amount of a molten material being injected to the mold cavity reaches the capacity of the mold cavity," this language is taken to be an intended use.
 - Regarding **claim 5**, Honda discloses the temporary space being situated in the mold cavity space and delimited and capable of being eliminated at a predetermined time by an eliminator, the eliminator being a movable pin having the outside shape fit to the inside shape of the through hole of a target product (page 3, upper right column, line 20 to lower right column, line 5). "...and is started to be inserted to the mold

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cavity to occupy the temporary space when the melt front of a molten material passed the position of the temporary space" is taken to be an intended use.

6. **Claims 1, 2 and 5** are rejected under 35 U.S.C. 102(b) as being anticipated by Shin-Kobe (JP 4-290714).

- Regarding **claims 1 and 2**, Shin-Kobe discloses a mold for injection molding, including a mold cavity having an inside shape fit to an outside shape of a target product, a junk cavity being communicated with the mold cavity, and a temporary space being communicated with the mold cavity and capable of being eliminated (¶¶ 6 and 9). With respect to the recitation "...eliminated before an amount of a molten material being injected to the mold cavity reaches the capacity of the mold cavity," this language is taken to be an intended use.
- Regarding **claim 5**, Honda discloses the temporary space being situated in the mold cavity space and delimited and capable of being eliminated at a predetermined time by an eliminator, the eliminator being a movable pin having the outside shape fit to the inside shape of the through hole of a target product (¶¶ 6 and 9). "...and is started to be inserted to the mold cavity to occupy the temporary space when the melt front of a molten material passed the position of the temporary space" is taken to be an intended use.

7. **Claims 1 and 7** are rejected under 35 U.S.C. 102(b) as being anticipated by Kabushiki (JP 2002-316347).

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- Regarding **claim 1**, Kabushiki discloses a mold for injection molding, including a mold cavity having an inside shape fit to an outside shape of a target product, and a temporary space being communicated with the mold cavity and capable of being eliminated (¶¶ 32-34). With respect to the recitation "...eliminated before an amount of a molten material being injected to the mold cavity reaches the capacity of the mold cavity," this language is taken to be an intended use.
- Regarding **claim 7**, Kabushiki discloses the mold cavity having a body corresponding to a through hole of a target product and jut into the mold cavity space to cause a branch and a confluence of the molten material, the temporary space being set at the confluence side of the body and capable of being eliminated (¶¶ 32-34). "...said eliminator is started to eliminate the temporary space to push and return a molten material accumulated in the temporary space to the mold cavity" is taken to be an intended use.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LARRY THROWER whose telephone number is 571-270-5517. The examiner can normally be reached on Monday through Friday from 9:30AM-6PM est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina A. Johnson can be reached on 571-272-1176. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Larry Thrower/
Examiner, Art Unit 1791

/Christina Johnson/

Supervisory Patent Examiner, Art Unit 1791